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20185	7590	07/27/2007	EXAMINER	
FRANCIS L CONTE 6 PURITAN AVENUE SWAMPSCOTT, MA 01907				ROWAN, KURT C
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 10/643,288

JUL 27 2007

Filing Date: August 20, 2003

Appellant(s): CONTE, FRANCIS LUCA

GROUP 3600

Francis Conte
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief March 30, 2007 appealing from the Office action

mailed 2/7/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

96-3971 and 02-1150 in the parent case and 2006-0635 in the present application.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

1779507	WHITE	10/1930
2642057	WATKINS	6/1953
102594	ROBINSON	5/1870

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 5, 6, 8, 10-14, 17-23 are rejected under 35 USC 103 as being obvious over White in view of Watkins.

Claim 9 is rejected under 35 USC 103 as being obvious over White in view of Watkins and further in view of Robinson.

Claims 1, 3, 5, 6, 8, 10-23 are rejected under 35 USC 103 as being obvious over Watkins in view of White.

(10) Response to Argument

In response to applicant's argument that White and Watkins are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Watkins and White are both reasonably pertinent to the particular problem with which applicant was concerned which is killing insects. Watkins and White shot or project rubber bands and hence are capable of killing insects. Applicant argues that both White and Watkins have no pertinence to applicant's stated problems for

which the lash (rubber band) must not be shot away. However, Watkins shows the lash 14 being maintained on the rubber band gun due to keyhole slot 34 noting Figs. 1-2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge is generally available to one of ordinary skill in the art. Further there is a reasonable expectation of success in combining the references since both are merely rubber band guns which function in the same way. Further the references when combined teach or suggest all of the claim limitations. The present invention uses a slot 30 as shown in Fig. 2 to retain the rubber band. White is not cited to show the rubber band or lash fixed to the rubber band gun. Watkins shows the same slot 34 to retain the rubber band with the only difference being that in the present invention, the slot opens to the bottom of the rubber band gun while in Watkins, the slot opens to the top of the rubber band gun. The function is exactly the same for each. Watkins would function to destroy insects just like the present invention be it the pea of the forward projecting lash as shown in Fig. 4. It should be pointed out that inherently both White and Watkins have proximal and distal ends and in both references, the lash is expressly shorter than the rod so that it can be elastically stretched to position the lash distal end at the rod proximal end. Applicant's

arguments pertaining to White not having a proximal or distal ends of the lash since they are not fixedly attached have been noted, but see Fig. 1 of White with three connected 19 lashes mounted to the gun. See page 1, lines 86-98. Either end of the lash can be considered as a proximal end and the other end then becomes the distal end. Applicant states that White would be rendered inoperative if the three rubber bands were prevented from being shot away. However, this is not the case and applicant has submitted no evidence to prove that White would be inoperative noting that the purpose of White, as stated on page 1, lines 1-22 is that the gun will be discharged in a straight line toward the object aimed at. This object is fulfilled if the rubber bands leave the gun or if one end of the lash is mounted in a slot and stays in contact with the gun. The rubber bands of White can be considered to be identical noting that cutting an inner tube of a constant diameter would produce rubber bands of the same length when cut perpendicular to the length of the tube. However, if the rubber bands are cut differently, some at a 90 degree angle and some at an angle of say 45 degrees, they would have a different length since the diagonal ones would be longer. Applicant states that 1930 tubes would have to be quite small to be assembled together in the three band illustration in White and what 1930 vehicle would have such small tubes, but wheels of the day tended to have large diameters with small tires. At any rate, White clearly found one that met his requirements. However, White is not precluded from using rubber bands of different sizes. White can use one, two, or three rubber bands as stated in lines 87-88. However, White is not cited to show two rubber bands fixed at one end and loose at the other. Watkins shows a rubber band fixed on one end and loose on the

other. It is unlikely that an insect would know the difference from a liberated lash or from a lash used like a whip. The rubber band guns of White and Watkins are not fundamentally different from each other since both project a rubber band or a lash at a target. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In regard to Robinson, applicant argues that Robinson is nonanalogous art, but again Robinson is reasonably pertinent to applicant's rubber band gun noting that rubber band guns are classified together regardless if they are called toy guns or are used to kill insects. The cord of Robinson is elastic serves the same function as the elastic bands used by Watkins and White. Hence one would look not only to insect killing rubber band guns but also to toy guns in considering the relevant prior art. Robinson is cited to show mounting the lash on the bottom of the gun while Watkins mounts the lash to the top of the gun.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Kurt Rowan


KURT ROWAN
PRIMARY EXAMINER
GROUP 3200

Conferees:

Meredith Petravick 

Frank Palo 